

Notice of Allowability

Application No.

10/672,710

Examiner

Robert Shiao

Applicant(s)

EPSTEIN ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on 08/09, 2004.
2. ☒ The allowed claim(s) is/are 11-18, now are 1-8.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

1. This application claims benefit of the provisional application: 60/314,585 with a filing date 08/24/2001.
2. Amendment of claims 11 and 15, and cancellation of claims 1-10 and 19-25 in the amendment filed on August 09, 2004, is acknowledged. Claims 11- 18 are pending in the application.

Responses to Amendment

3. Since limitation of "ras-associated diseases" has been incorporated into claim 11, therefore, the rejection of claims 11-18 under 35 U.S.C. 112, first paragraph, has been overcome in the amendment filed on August 09, 2004. Since claim 19 has been cancelled, therefore, the rejection of claim 19 under 35 U.S.C. 112, first paragraph, is obviated.
4. Since the scope of "optionally mono or di-substituted of phenoxy, phenyl or benzyloxy" of the compound of formula I has been incorporated, therefore, the rejection of claims 11-18 under 35 U.S.C. 112, second paragraph, has been overcome in the amendment filed on August 09, 2004. Since claim 19 has been cancelled, therefore, the rejection of claim 19 under 35 U.S.C. 112, first paragraph, is obviated.

EXAMINER'S AMENDMENT

5. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided

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by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Daniel B. Moran on October 14, 2004. The application has been amended as follows:

In claim 11, page 4, line 9, after "phenoxy, and benzyloxy,", delete "and benzyloxy"

In claim 11, page 4, lines 17-18, after "phenoxy, and benzyloxy,", delete "and phenoxy"

Reasons for Allowance

6. The following is an examiner's statement of reasons for allowance:

Claims 11-18 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to 3-substituted-3-(substitutesulfonyl or sulfonyl)pyrrolidine-2,5-diones useful for inhibition of farnesyl-protein. The instant compounds of formula (I) also are used for controlling metastasis, suppressing angiogenesis, and inducing apoptosis. The closest reference is Epstein et al. US 6,740,675 (i.e., application No. 10/227,215), discloses compounds/compositions of formula (I). The difference between instant claims and Epstein et al is that the instant claimed methods of use of formula (I) are not claimed by Epstein et al. Suggestion for

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modification of reference to obtain the instant methods of use has not been found.

Claims 11-18 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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R. Desai

for

Joseph K. McKane
Supervisory Patent Examiner
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10/20/04

Rb-

Robert Shiao, Ph.D.
Patent Examiner
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October 19, 2004